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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,562	11/01/2000	William C O'Neil, Jr.	TFFUND-04809	3102
23535	7590	10/08/2004	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			CHAMPAGNE, DONALD	
		ART UNIT	PAPER NUMBER	
		(2121)		

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/703,562	O'NEIL, JR. ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 09 July 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,4-9,11-16,24-27 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-9,11-16,24-27 and 29-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 November 2000 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-26-04</u> . | 6) <input type="checkbox"/> Other: _____.  |

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 July 2004 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1, 4-9, 11-16, 24-27 and 29-34 are rejected under 35 U.S.C. 103(a) as obvious over Lidman (US005471669A) in view of Schultz et al. (US pat. 5,056,019).
4. Lidman teaches (independent claims 1, 24 and 33) a method and a system, the method comprising: providing a *purchaser* with an *account 50*, which reads on a registered member, at least one higher education account, and at least one participating merchant (*store 20* with *cash register 110*), which reads on a registered merchant (para. 5 below), offering discount *coupons*, which reads on a rebate (col. 2 lines 41-43 and col. 4 line 24), and a rebate network manager (*cash register 110* and *clearinghouse 30*, col. 4 line 29); calculating (col. 3 lines 5-6) said coupon rebate on purchases made by said registered member from said registered merchant, wherein said rebate network manager/*cash register 110* reads the *purchaser*/registered member account information in conjunction with reading the purchases (col. 2 lines 52-54), which reads on monitoring sales by said registered merchant/*store 20* to determine if said sales are to said *purchaser*/registered member, and wherein said calculating step is performed by said rebate network manager/*cash register 110* utilizing a computer processor (col. 2 line 51) configured to calculate said rebate; and crediting said at least one higher education account with said rebate (col. 1 lines 26-31 and 42-46). For

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- claim 24, Lidman teaches college and educational savings accounts (col. 1 lines 26-31 and 55-56), which reads on member higher education accounts.
5. The merchant/*store 20* participates in the method by permitting use of its *store coupons and store increases of manufacturer's coupons* and permitting transfers from the *store's account 132* to the registered member/*purchaser's account 50 at bank 130* (col. 3 lines 4-13). By virtue of having an account with said *bank 130*, said merchant/*store* must be enrolled in the records of *bank 130*, which makes it a merchant/*store* registered with *bank 130* (Merriam-Webster's Online Dictionary definition of "register").
  6. In addition, the limitations "registered" member and "registered" merchant are nonfunctional descriptive matter that do not warrant patentable weight. Being "registered" does not exhibit any functional interrelationship with the way in which the computing process is performed. See MPEP 2106.IV.B.1(b), first paragraph.
  7. Libman does not teach that said computer processor is located at location other than the location of the merchant. Schultz et al. teaches that said computer processor (*PMCS 4*, col. 5 lines 44-56) is located at location other than the location of the merchant. Because Schultz et al. teaches that this allows the invention to service multiple *retail outlets 20 of different retail chains*, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Schultz et al. to those of Libman.
  8. Lidman also teaches at the citations given above claims 4-5, 7-8, 11, 15 and 30. Lidman also teaches at the citations given above claims 16 and 29, where the *bank 130* that is the custodian of *customer account 50* and *store account 132* reads on a registration organization, which inherently must be paid (receives a portion of said rebate).
  9. Lidman also teaches: a college fund savings account (claims 6, 25 and 34, at col. 1 line 26-31 and 55); claims 12 and 27 (col. 3 line 38); and claims 14 and 32 (col. 2 line 43, which teaches a *cash register 110*, which reads on an on-site merchant).
  10. Lidman does not teach that (claims 9 and 26) the rebate is from 1% to 30% of the price of said purchases or (claims 13 and 31) purchases made on-line. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed on 15 December 2003 (para. 17 of paper No. 6). This statement is taken to be admitted

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prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

11. Lidman does not teach (claim 21) an educational IRA or (claim 23) a college charitable contribution account. Because these accounts support education, and would therefore attract business to participating merchants, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these kinds of accounts to the teachings of Lidman.

### ***Conclusion***

12. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Feidelson et al. (US006345261B1), teaches some aspects of the instant invention.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
14. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
15. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

29 September 2004

DONALD L. CHAMPAGNE  
PRIMARY EXAMINER



Donald L. Champagne  
Primary Examiner  
Art Unit 3622